

Application No. 09/786,435
Filed: March 20, 2001
TC Art Unit: 1645
Confirmation No.: 1324

REMARKS

This is a response to the Office Action finally rejecting pending claims 1, 5, 6, 8, and 14-18. Applicant acknowledges with appreciation that all previous prior art rejections of method claims 1 and 14-18 have been withdrawn. Composition claims 5, 6 and 8 are hereby cancelled.

Applicant's amendment or cancellation of certain rejected claims is not to be construed as an admission that the Examiner's rejections were proper. The Applicant continues to believe that all the rejected claims are described in and enabled by the specification, and are neither anticipated by nor obvious in view of the cited references, as previously argued. The rejected claims have been amended or cancelled for the sole purpose of advancing the case to allowance. The Applicant reserves the right to file a continuing application to continue the prosecution of the rejected claims.

Procedural Matter

When the instant application was filed on March 2, 2001, under 35 U.S.C. § 371, it was accompanied by an Information Disclosure Statement, which included a Form PTO-1449 (copy enclosed) listing the International Search Report and the patent documents and articles cited therein. On April 12, 2001, the office of the Applicant's undersigned attorney received the Notification of Acceptance of Application (copy also enclosed), which listed, among other items, receipt of the Information Disclosure Statement, a copy of the International Search Report and copies of the references cited therein.

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In reviewing the file, however, Applicant has noted that a copy of the referenced Form PTO-1449 initialed by the Examiner as being reviewed has never been returned to this office. Therefore, Applicant respectfully requests that the Examiner initial and return this Form with the next Paper sent to Applicant.

Rejections Under 35 U.S.C. § 112

Claims 1 and 15-18 are newly rejected as indefinite. These rejections are respectfully traversed in light of the amendments made herein and reconsideration is requested.

Applicant submits that these amendments are supported throughout the specification. Thus, no new matter has been added. Specifically, the wording of claim 1 has been rearranged to address the Examiner's concerns expressed in points 5 and 7 on page 7 of the Action. In point 6, the Examiner mentions that while claim 1 recites a "first" compound, there is no "second" compound recited in that claim. Applicant had used the terminology "first" compound in claim 1 to provide differential antecedent reference for the introduction of a "second" compound in an additional treatment step in dependent claim 16. However, the Applicant will abide by the Examiner's preference and has amended claims 1, 14-16 and 18 as indicated to replace "first compound" with "compound."

Rejections Under 35 U.S.C. § 102

1) Claims 1, 14 and 18 are newly rejected as anticipated by Henrich-Noack et al. (Stroke). This rejection is respectfully traversed and reconsideration is requested.

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First, as acknowledged by the Examiner, test rats as described in Henrich-Noack et al. were administered a test compound one hour before ischemia (emphasis added). Therefore, the limitation in Applicant's claim 1 that the patient to be treated already have damaged neurons is not taught in Henrich-Noack et al. Furthermore, the test compound administered in Henrich-Noack et al. is transforming growth factor- β 1 (TGF- β 1) itself, the exact opposite of what is required by Applicant's claim 1, which is "a compound that inhibits the biological activity of transforming growth factor- β 1 (TGF- β 1), transforming growth factor- β 2 (TGF- β 2) and/or transforming growth factor- β 3 (TGF- β 3) on damaged neurons in a cerebral disorder" (emphasis added). Thus, Henrich-Noack et al. does not disclose all the limitations of Applicant's claim 1, and claims 14 and 18 dependent thereon, and cannot anticipate the claimed invention.

2) Claims 1, 14 and 18 are newly rejected as anticipated by Krieglstein (*European Journal of Pharmaceutical Sciences*). This rejection is respectfully traversed and reconsideration is requested.

The teachings of this reference are similar to those of Henrich-Noack et al. and, thus, opposite to the method claimed by the Applicant. Krieglstein teaches treating hippocampal neurons with (TGF- β 1), during an excitotoxic exposure, not, as required by Applicant's claimed method, treating already damaged neurons with an inhibitor of TGF- β 1. Thus, Krieglstein, also, does not disclose all the limitations of Applicant's claim 1 and claims 14

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and 18 dependent thereon and cannot anticipate the claimed invention.

3) Claims 1, 14 and 15 are newly rejected as anticipated by Krieglstein et al. (*Neurochemical Research*). This rejection is respectfully traversed and reconsideration is requested.

With respect, Applicant submits that the Examiner has misinterpreted certain aspects of this reference. First, the model system used in this reference is a chick embryonic system in which developing sensory neurons are being studied, not damaged neurons as in the patient population being treated in the Applicant's claimed method. Second, the caption to Fig. 5 at p. 847 states that "[n]eutralizing antibodies to TGF- β 1/2/3 . . . reduced neuronal survival" (emphasis added), the exact opposite to the effect achieved when the patient population of Applicant's claim 1 is treated. Therefore, this reference also cannot anticipate the claimed invention.

As none of the references cited under 35 U.S.C. § 102, discloses all of the limitations of the Applicant's claims, Applicant submits that the rejection for anticipation has been overcome.

Rejections 35 U.S.C. § 103(a)

Claims 1, 14 and 15-18 have been rejected as obvious over Henrich-Noack et al. in view of Alexander et al. and further in view of Mattson et al. These rejections are respectfully traversed and reconsideration is requested.

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Applicant had described above the deficiencies of Henrich-Noack et al. These deficiencies are not cured by a combination of Henrich-Noack et al. with Alexander et al. and/or Mattson et al. Thus, Applicant submits that the combination of Henrich-Noack et al. with Alexander et al. and/or Mattson et al. neither teaches nor fairly suggests all the limitations of the Applicant's claims and the rejection for obviousness is overcome.

For the reasons indicated above, Applicant submits that all pending claims are in condition for allowance and such action is requested.

The Examiner is strongly encouraged to telephone the undersigned attorney to discuss any matter that would expedite allowance of the present application.

Respectfully submitted,

KERSTIN KRIEGLSTEIN

By: Holliday C. Heine
Holliday C. Heine, Ph.D.
Registration No. 34,346
Attorney for Applicant(s)

WEINGARTEN, SCHURGIN,
GAGNEBIN & LEOVICI LLP
Ten Post Office Square
Boston, MA 02109
Telephone: (617) 542-2290
Telecopier: (617) 451-0313

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WEINGARTEN, SCHURGIN,
GAGNEBIN & LEOVICI LLP
TEL. (617) 542-2290
FAX. (617) 451-0313